

### Remarks

Claims 1-26 remain in this application. Claims 1, 17 and 20 were amended above. Claims 1, 17 and 20 were amended above to further describe the detector as a non-imaging detector and to further describe the detecting step as one without imaging. These amendments do not introduce new matter. Support for these amendments can be found throughout the specification, for example, on page 3, lines 19-20, and page 4, lines 22-23. New claims 23, 24, 25 and 26 were added by amendment above, and are supported throughout the specification, for example, on page 6, lines 8-30. It is respectfully requested that the new claims and amended claims be entered into the application. The specification was amended to add reference the application to which the present application claims priority.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached pages are captioned "Version with marking to show changes made."

### Information Disclosure Statement

The Office Action mailed September 21, 2000 pointed out errors in the Information Disclosure Statement. We apologize. A new IDS has been submitted herewith correcting the errors. It is therefore respectfully requested that the references submitted herewith be considered by the Examiner.

### 35 USC §§102 and 103 Rejections over Duggan

The Office Action rejected claims 1, 2, 4, 10, 11, 15, 17, 19, 20 and 22 under 35 USC §102 as being anticipated by Duggan et al (US Patent 6,124,594). Additionally, claims 5-7, 9, 13, 14, and 16 were rejected under 35 USC §103 as being unpatentable over Duggan et al. Applicants have faxed herewith is a copy of a Rule 131 Declaration by Timothy P. Newton that was originally prepared and mailed to the USPTO for a response in US Serial No. 10/051,992. US Serial No. 10/051,992 is a continuation-in-part of US Serial No. 09/187,579. The present application is a continuation of US Serial No. 09/187,579. The Rule 131 Declaration states that Applicants' invention was conceived and reduced to practice prior to the filing date of Duggan et al. Therefore, Duggan et al is not a prior art reference.

Therefore, it is respectfully requested that the 35 U.S.C. §102 and 103 rejections of Applicants' invention over Duggan et al be withdrawn.

35 USC §102 Rejection over Ebel

The Office Action rejected claims 1 and 2 under 35 USC §102 as being anticipated by Ebel et al (US Patent 5640464). The Office Action states:

"With respect to independent claim 1, Ebel et al. discloses an apparatus 10 (Fig. 1) for detecting the presence of an ophthalmic product 76 in a container 66 (Fig. 2) comprising a source 36 of electromagnetic energy located relative to the container to direct electromagnetic energy 80 (Fig. 5) at the container, a detector 42 disposed relative to the container 66 and the source 36 to detect electromagnetic energy from the source which passes through the product 76 and the container 66, and means 20 for indicating the presence of the product 76 in the container 66 (column 3, lines 18-21) responsive to absorption of the electromagnetic energy by the product (column 5, lines 34-40).

With respect to dependent claim 2, the product 76 in the apparatus of Ebel et al. In a contact lens (column 1, line 9)."

Applicants traverse this rejection. Ebel does not disclose the use of a detector. Ebel teaches the inclusion of a camera having a pixel array which captures an image of packages and then does a complicated computer analysis of the image captured by the camera to determine if contact lenses are present in the packages. (See, for example, Ebel, col. 5, lines 59-67). A detector or detectors used in the apparatus and method of Applicants' invention do not create an image; and do not do a complicated pixel-by-pixel analysis of an image; therefore, Applicants' invention is novel over Ebel. As stated above, Applicants have amended claim 1 to define the detector as a "non-imaging detector" and claims 17 and 20 to specify that the detecting step is done "without imaging". It is therefore respectfully requested that the 35 U.S.C. §102(b) rejection of claims 1 and 2 over Ebel be withdrawn.

35 USC §103 Rejection over Collins

The Office Action rejected claims 1-3, 5-11, 13-18, 20, and 21 under 35 U.S.C. 103(a) as being unpatentable over Collins et al. (US005633504A).

The Office Action states:

With respect to independent claim 1, Collins et al. Discloses an apparatus (Fig. 1) comprising a source 12 of electromagnetic energy located relative to a container 16 to direct electromagnetic energy thereat, a detector 22 disposed relative to the container 16 and the source 12 to detect electromagnetic energy from the source which passes through or is reflected by an ophthalmic product 20 and the container 16, and means (a video monitor, column 3, lines 3-4) for indicating the presence or position of the product 20 in the container 16 responsive to one of the fluorescence, absorption, or reflection of the electromagnetic energy by the product 20. It would have been obvious to one of ordinary skill in the art at the time the invention was made that the described video monitor afforded detection of the presence or position of the ophthalmic product 20 in the container 16.

With respect to dependent claim 2, the product 20 in the apparatus of Collins et al. is a contact lens (column 2, line 11).

With respect to dependent claim 3, the source 12 in the apparatus of Collins et al. may emit in the ultraviolet range (column 2, lines 47-52).

With respect to dependent claim 5, the contact lens 20 in the apparatus of Collins et al. may contain an ultraviolet absorbing media (column 4, lines 30-63).

With respect to dependent claims 6 and 7, the utility of the ultraviolet absorbing media contained in the contact lens 20 in the apparatus of Collins et al. is a choice within the ordinary skill in the art in view of the desired performance.

With respect to dependent claim 8, the source 12 in the apparatus of Collins et al. may emit in the visible range (column 2, lines 52-55) and the contact lens 20 contains a tint based on its dark appearance (column 2, line 41) with respect to transmission of the visible fluorescence created in the embodiment in which the container 16 is made to fluoresce.

With respect to dependent claim 9, the lens 20 in the apparatus is considered to be a hygroscopic lens in view of the hydration suggested (column 3, lines 62-64).

With respect to dependent claim 10, the embodiment described by Collins et al. at column 2, lines 36-43 includes a lens 20 and a container 16 serving as a receptacle that differ in their absorption or reflection of electromagnetic energy in the visible range.

With respect to dependent claim 11, the embodiment described by Collins et al. at column 2, lines 36-43 includes a lens 20 which absorbs electromagnetic energy (the fluorescence of the container 16) to which the detector 22 is sensitive.

With respect to dependent claim 13, the detector 22 in the apparatus of Collins et al. is a video camera (column 2, line 63). The use of any particular type of detector is a choice within the ordinary skill in the art in view of the desired performance.

With respect to dependent claim 14, a filter is described by Collins et al. at column 2, lines 55-62.

With respect to dependent claim 15, the detector 22 in the apparatus of Collins et al. is a video camera (column 2, line 63). The use of any particular type of detector is a choice within the ordinary skill in the art in view of the desired performance.

With respect to dependent claim 16, a filter is described by Collins et al. at column 2, lines 55-62.

With respect to independent claim 17, Collins et al. suggests a method corresponding to the disclosed apparatus (Fig. 1) which would comprise the steps of directing electromagnetic energy (using source 12) at an ophthalmic product 20 and container 16, detecting (using detector 22) electromagnetic energy from the source which passes through or is reflected by the product 20 and the container 16, and processing (using a video monitor, column 3, lines 3-4) the detected electromagnetic energy to determine the presence or position of the product 20 in the container 16. It would have been obvious to one of ordinary skill in the art at the time the invention was made that the described video monitor afforded detection of the presence or position of the ophthalmic product 20 in the container 16.

With respect to dependent claim 18, the source 12 used in the method of Collins et al. may emit in the ultraviolet range (column 2, lines 47-52).

With respect to independent claim 20, Collins et al. suggests a method corresponding to the disclosed apparatus (Fig. 1) which would

comprise the steps of directing electromagnetic energy (using source 12) at an ophthalmic product 20 and container 16, detecting (using a video monitor, column 3, lines 3-4) the detected electromagnetic energy to determine the presence or position of the product 20 in the container 16. It would have been obvious to one of ordinary skill in the art at the time the invention was made that the described video monitor afforded detection of the presence or position of the ophthalmic product 20 in the container 16.

With respect to dependent claim 21, the source 12 used in the method of Collins et al. for the electromagnetic energy of step (a) may emit in the ultraviolet range (column 2, lines 47-52). The electromagnetic energy of step (b) has no necessary relation thereto.

Applicants traverse this rejection. Collins discloses a camera and imaging steps in the inspection of lenses. Applicants' invention provides that the detection is done without imaging, which is not taught or suggested by Collins. Therefore, it is respectfully requested that the 35 U.S.C. §103 rejection over Collins of claims 1-3, 5-11, 13-18, 20 and 21 be withdrawn.

Claims 2, 3, 5, 9, 10, 14, 16, 18, and 21 were further rejected over Collins and are allowable for the reasons discussed above for the allowance of claim 1, and because the specific combinations of limitations present in those claims are not taught or suggested by Collins.

With respect to claims 6 and 7, the Office Action states that Collins discloses ultraviolet absorbing media contained in the contact lens; therefore, the invention of claims 6 and 7 are obvious, because they claim ultraviolet blocker and ultraviolet photoinitiator. These rejections are traversed. Claims 6 and 7 are allowable for the same reasons claims 1 and 2 are allowable. Further, Collins does not teach the use of a ultraviolet blocker or ultraviolet photoinitiator. To state that Collins does, without any additional evidence, is to read Applicants' invention into Collins disclosure which is an improper hindsight reconstruction of the reference. It is therefore respectfully requested that the rejection of claims 6 and 7 be withdrawn.

Applicants traverse the rejections of claims 8, and 11 for the same reasons claims 1 and 2 are allowable and for the following additional reason. Collins does not disclose that the contact lens in col. 2, lines 36-43 contains a tint, nor does it disclose what exactly is the method by which the lens appears as a dark body,

surrounded by light, which can only mean that this is a hindsight reconstruction of the art whereby Applicants' invention is being used against it, to, in this case, read into Collins' disclosure a limitation claimed by Applicants. Therefore, it is respectfully requested that the rejections of claims 8 and 11 be withdrawn.

Applicants traverse the rejections of claims 13 and 15 for the same reasons claims 1 and 2 are allowable and for the following additional reason. The use of a camera as a detector does not teach or suggest Applicants' invention which is to use the specific non-imaging detectors: a calorimeter and spectrometer, claimed in claims 13 and 15 to determine if a lens is present in a package. Therefore, it is respectfully requested that the rejections of claims 13 and 15 over Collins be withdrawn.

Applicants traverse the rejections of independent claims 17 and 20 for the same reasons claims 1 and 2 are allowable and for the following additional reason. The Office Action rejected claim 17 because, Collins teaches "detecting (using a detector 22)" and "processing (using a video monitor,...". These rejections are traversed. Collins does not disclose a "detector 22"; it is a camera 22 (col. 2, line 16) which is not a non-imaging detector, and therefore, does not make Applicants' invention obvious. Therefore, it is respectfully requested that the rejections of claims 17 and 20 be withdrawn.

#### 35 USC §103 Rejection over Collins

The Office Action rejected claims 8, 9 and 12 under 35 USC §103 as being unpatentable over Ebel et al. The Office Action states:

"With respect to dependent claim 8, the source 36 in the apparatus of Ebel et al. emits electromagnetic energy in the visible range (column 4, line 28). The utility of the apparatus 10 when the contact lens 76 contained a tint would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the recognition of light attenuation at column 5, lines 34-40.

With respect to dependent claim 9, one of ordinary skill in the art would have found it obvious to recognize that the contact lens 76 detected by the apparatus of Ebel et al. was hygroscopic as this is a typical item of manufacture.

With respect to dependent claim 12, the apparatus of Ebel et al. further comprises a plurality of detectors 42 disposed therein (Fig. 1).

Although Ebel et al. describes a single source 36, one of ordinary skill in the art at the time the invention was made would have found it obvious to modify the apparatus 10 to further comprise a plurality of sources disposed therein in view of the flexibility this affords in installing the apparatus in a production line, for example, should there be a return belt of the conveyor."

Applicants traverse these rejections. Claim 8 is allowable for all the reasons discussed above why claims 1 and 2 are allowable over Ebel, that is, that there is no teaching or suggestion to use a detector, and for the additional reason that at col. 5, lines 34-40, there is no teaching or suggestion to use a tinted lens to attenuate the light passing through the lens; therefore, Ebel does not make Applicants' invention of claim 8 obvious. Claims 9 is patentable over Ebel for the same reasons as discussed above for claims 1 and 2.

The Office Action states that with respect to claim 12, Ebel discloses a plurality of detectors, and that although Ebel only discloses one source, it would be obvious to modify Ebel's apparatus to comprise multiple sources. Claim 12 is allowable for all the reasons discussed above why claims 1 and 2 are allowable over Ebel, and for the additional reason that Ebel has no teaching or suggestion to use multiple sources; therefore, Ebel does not make Applicants' invention of claim 3 obvious

Therefore, all the claims are patentable over Ebel. It is respectfully requested that the rejections of the claims 8, 9, and 12 under 35 U.S.C. §103(a) over Ebel be withdrawn.

It is presently believed that claims 1-26 are presently in condition for

allowance. The allowance of claims 1-26 as a patent is therefore respectfully requested.

Respectfully submitted,



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**Version with marking to show changes made**

**In the Specification:**

On page 1, line 2, kindly insert the following paragraph:

—This is a continuation of US Serial No. 09/187,579 filed November 5, 1998, which issued as US Patent 6,246,062 on June 12, 2001. —

**In the Claims:**

Claims 1, 17, and 20 were amended as follows:

1. (Amended once) An apparatus for detecting the presence or position of an ophthalmic product in a container, comprising:

d) source of electromagnetic energy located relative to the container to direct electromagnetic energy at the container;

e) a non-imaging detector disposed relative to the container and the source to detect electromagnetic energy from the source which passes through or is reflected by the product and the container; and

f) means for indicating the presence or position of the product in the container responsive to fluorescence, absorption or reflection of the electromagnetic energy by the product.

17. (Amended once) A method for detecting the presence or position of an ophthalmic product in a container, the product including a media which fluoresces, absorbs or reflects electromagnetic energy of a frequency in a specified range, the method comprising:

(a) directing electromagnetic energy of a frequency in the specified range at the product and the container;

(b) detecting, without imaging, the electromagnetic energy which passes through or is reflected by the product and the container; and

(c) processing the detected electromagnetic energy to determine the presence or position of the product in the container.

20. (Amended once) A method for detecting the presence or position of an ophthalmic product in a container, the product including a media which fluoresces, absorbs or reflects the electromagnetic energy of a frequency in a specified range, the method comprising:

- (a) directing electromagnetic energy at the product and the container;
- (b) detecting, without imaging, the absence of or reduction in electromagnetic energy of a frequency in a specified range which passes through or is reflected by the product and the container; and
- (c) processing the detected electromagnetic energy to determine the presence or position of the product in the container.

New claims 23 and 24 were added to the application as follows:

—23. An apparatus as defined in claim 2, wherein the source emits electromagnetic energy having a wavelength in the ultraviolet range, and said detector is sensitive to the electromagnetic energy in the ultraviolet range.

24. An apparatus as defined in claim 2, wherein the source emits electromagnetic energy having a wavelength in the ultraviolet range, and the detector is sensitive to the electromagnetic energy in the ultraviolet range, and the contact lens absorbs electromagnetic energy having a wavelength in the ultraviolet range.

25. An apparatus as defined in claim 2, wherein the source emits electromagnetic energy having a wavelength in the visible range, and the detector is sensitive to the electromagnetic energy in the visible range, and the contact lens absorbs electromagnetic energy having a wavelength in the visible range.

26. An apparatus as defined in claim 2, wherein the source emits electromagnetic energy having a wavelength in the infrared range, and the detector is sensitive to the electromagnetic energy in the infrared range, and the contact lens absorbs electromagnetic energy having a wavelength in the infrared range. —

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**DATE: October 23, 2002**

**TO:** Examiner Constantine Hannaher  
Art Unit 2878  
United States Patent & Trademark Office

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**NUMBER OF PAGES INCLUDING THIS COVER SHEET:** 58

**RE:** US Serial 09/819,074

VTN-0564

Petition For Extension of Time -- (3 copies)

Amendment (13 pages)

Information Disclosure Statement (4 pages) + 2 copies of last page

PTO 1449 with 2 references (28 pages)

Rule 131 Declaration (4 pages)

Transmittal Form (3 copies)

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Case Docket No.: VTN-0564

In re application of Ross, Denwood F. et al.

Serial No. 09/819,074

Filed: June 5, 2001

For: Missing Lens Detection System

ASSISTANT COMMISSIONER FOR PATENTS  
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Sir:

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Transmitted herewith is an amendment in the above-identified application.

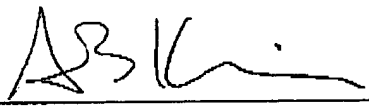
- ☐ No additional fee is enclosed because this application was filed prior to October 25, 1965 (effective date of Public Law 89-83).
- ☐ No additional fee is required.
- ☐ One stamped, self-addressed postcard for the PTO Mail Room date stamp.
- ☒ Petition For Extension of Time and charge to Deposit Account of Appropriate Fee.

The fee has been calculated as shown below.

## CLAIMS AS AMENDED

(1)	(2)	(3)	(4)	(5)	(6)	(7)
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDITIONAL FEE
TOTAL CLAIMS	26	minus	22	4	x \$18	=\$ 72.00
INDEP. CLAIMS	3	minus	3	0	x \$80	=\$ 0.00
MULT. DEP. CLAIMS	<input type="checkbox"/>				\$ 270	=
TOTAL ADDITIONAL FEE FOR THIS AMENDMENT						=\$ 72.00

- ☒ Charge ~~\$270~~<sup>72.00</sup> to Deposit Account No. 10-0750/VTN0564/AK. Three copies of this sheet are enclosed.
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